

Appl. No. : 10/032,215
Filed : December 21, 2001

REMARKS

In the Office Action mailed December 23, 2003, the Examiner rejected Claims 1-30. Claims 1, 10, and 19 have been amended, Claims 22-29 have been canceled, and Claim 31-37 have been added. No new matter has been added. Thus, Claims 1-18, and 30-37 are presented for further examination. Reconsideration and allowance of all Claims 1-30 in light of the present remarks is respectfully requested.

Discussion of Amendments to the Specification

Numbered paragraphs [0021] and [0028] of Applicant's specification are amended to clearly describe the filter adapter illustrated in the drawings. In particular, the amendments to numbered paragraphs [0021] and [0028] clearly describe the "chamber" formed by the perforated upper portion and perforated lower portion, that the magnet is disposed in this chamber, and that a central opening passes through this chamber (see Fig. 2)

Numbered paragraph [0027a] has been added in accordance with the Examiner's suggested amendment in the facsimile correspondence dated November 27, 2003 and corresponds to new claim 31. As noted above, the additions to the specification do not add new matter as all of the added subject matter was present in the figures as filed.

Rejections Under 35 U.S.C. § 102(e)

The Examiner has rejected Claims 1, 4-15, 19, and 20 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,349,693 to Reinos. Applicants respectfully disagree.

In regard to Claim 1, the Examiner stated that 'Reinos discloses and [sic] an adapter including a perforated upper portion 10 and a perforated lower portion 10, a centrally located opening 42 passing through the perforated upper portion and perforated lower portion and a removable hollow insert 24 mounted inside the opening extending through the perforated upper portion and the perforated lower portion and providing a first threaded portion 56 adapted to engage a threaded stud a second threaded portion 54 adapted to mount to a filter and a magnet 26 disposed within said adapter body for removing metallic particles from fluid.'

Appl. No. : 10/032,215
Filed : December 21, 2001

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053.

The magnetic filter adapter of amended Claim 1 comprises, *inter alia*, "an adapter body comprising a perforated upper portion and a perforated lower portion, wherein said perforated upper portion and perforated lower portion form a chamber; a centrally located opening passing through said perforated upper portion, said perforated lower portion, and said chamber; a removable hollow insert mounted inside said opening, extending through said perforated upper portion, said chamber, and said perforated lower portion .. ; and a magnet disposed within said chamber for removing metallic particles from said fluid."

Reinosa's bypass filter apparatus 30 includes two filter symmetrical elements 10 mated along a mating surface 40, wherein the mated symmetrical elements 10 define a bypass duct 14 containing a plurality of magnets 26. *Reinosa, col. 7, lines 45-54; Fig. 1*. A plurality of flow control orifices 16 are radially disposed around the symmetrical elements 10 to restrict the flow of lubricant fluid through the control orifices 16. *Col. 7, lines 56-60*. The filter apparatus 30 includes a fluid intake control orifice 18 and a fluid exhaust control orifice 20 positioned so as to allow maximum bypass flow exposure to the plurality of magnets 26 in the bypass duct 14. *Col. 7, line 60 – col. 8, line 6*. A nipple adapter 24 is inserted into a filter apparatus central passage 42 of the filter apparatus to hold the filter 30 in proper alignment with an engine block 44 and oil filter 32. *Col. 10, lines 4-10; Fig. 3*.

Reinosa, however, fails to describe a magnetic filter adapter comprising a perforated upper portion and perforated lower portion forming a chamber, a centrally located opening passing through the perforated upper and lower portions and the chamber; a removable hollow insert mounted inside the centrally located opening and extending through the chamber; and a magnet disposed in the chamber, as recited in amended Claim 1. In contrast to the magnetic filter adapter of amended Claim 1, the symmetrical elements 10 described by Reinosa do not form a chamber through which a centrally located opening passes through, and wherein a removable hollow insert extends through the chamber. If the duct 14 of Reinosa, wherein the magnets 26 are disposed, were capable of being interpreted as a chamber, the nipple adapter

Appl. No. : 10/032,215
Filed : December 21, 2001

would then be inserted into the central passage 42 of the apparatus 30 and the central passage would not pass through the duct 14 wherein the magnets 26 are located.

Thus, as Reinoso fails to describe, either expressly or inherently, each and every element as set forth in Claim 1, Applicant respectfully submits Claim 1 for further review as patentable subject matter.

Claim 10 recites limitations similar to those recited in Claim 1. Accordingly, the arguments with respect to Claim 1 similarly apply to Claim 10, and thus, Claim 10 is respectfully submitted for further review as patentable subject matter.

Because Claims 2-9, 11-18, and 30 depend from Claims 1 and 10, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features. For all of these reasons, Applicant respectfully requests withdrawal of this rejection.

In regard to Claim 19, the Examiner stated that "Reinoso discloses the steps of inserting a magnet 26 in a perforated lower portion 10 of a housing of an adapter, enclosing the magnet in the adapter by attaching a perforated upper portion 11 of a housing of the adapter to the perforated lower portion (e.g., via means 22), and inserting a hollow insert 25 in a centrally located opening 42 passing through the perforated upper portion and the perforated lower portion."

Claim 19 recites "a method of assembly of an adapter for removing metallic particles from a fluid, comprising: inserting a magnet in a perforated lower portion of a housing of said adapter; enclosing said magnet in said adapter by attaching a perforated upper portion of a housing of said adapter to said perforated lower portion, wherein said magnet is located in a chamber formed by said perforated upper portion and said perforated lower portion; and inserting a hollow insert in a centrally located opening passing through said perforated upper portion, said perforated lower portion, said chamber, and said magnet."

Reinoso, however, does not describe a method of assembly of an adapter, wherein a magnet is located in a chamber formed by a perforated upper portion and a perforated lower portion, and wherein the method comprises inserting a hollow insert in a centrally located opening passing through the chamber and the magnet.

Appl. No. : 10/032,215
Filed : December 21, 2001

Thus, as Reinoso fails to describe, either expressly or inherently, each and every element as set forth in Claim 19, for this reason, Applicant respectfully submits Claim 19 for further review as patentable subject matter.

Because Claims 20-21 depend from Claim 19, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features. For all of these reasons, Applicant respectfully requests withdrawal of this rejection.

Rejections Under 35 U.S.C. § 103

The Examiner has rejected Claims 1-18, and 30 under 35 U.S.C. § 103(a) as being unpatentable over PCT Application No. IB97/00040 to Vogrin (WIPO publication no. WO 97/26448; referred to as "Hueber" in the Office Action) in view of U.S. Patent No. 4,014,794 to Lewis. The Examiner has also rejected Claims 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Vogrin in view of Lewis, and further in view of U.S. Patent No. 4,237,015 to Fearnhead, and Claims 22-29 under 35 U.S.C. § 103(a) as being unpatentable over Vogrin in view of U.S. Patent No. 2,886,176 to Paton. Applicant respectfully disagrees. Claims 22-29 have been canceled.

In regard to Claim 1, the Examiner stated that Vogrin discloses "an adapter (see FIG. 1) including a perforated upper portion and a perforated lower portion, a centrally located opening passing through the perforated upper portion and the perforated lower portion a hollow insert (e.g., including parts 13 and 19) mounted inside the opening extending through the perforated upper portion and the perforated lower portion (see FIG. 1) ... , and a magnet 17 disposed within said adapter body"

The Examiner recognizes that Vogrin "fail[s] to specify the hollow insert as extending completely through the upper perforated portion and as being removable." However, the Examiner stated that "Lewis discloses a hollow insert 15 that extends through perforated upper and lower portions of an adapter and that is removable and suggests that such an arrangement facilitates assembly of the device." The Examiner asserted that it "would have been obvious to

Appl. No. : 10/032,215
Filed : December 21, 2001

have modified the adapter of Hueber et al so as to have included a hollow insert that was removable as suggested by Lewis in order to facilitate assembly of the device."

It is well-settled that "a showing of a suggestion, teaching, or motivation to combine [or modify] the prior art references is an 'essential component of an obviousness holding'." *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). The Examiner can satisfy the burden of showing obviousness of the combination or modification "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. *ATD Corp. v. Lycaall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

Applicant respectfully disagrees with the Examiner's assertion that it would have been obvious to modify the device described in Vogrin so as to include a removable hollow insert or "extended stud portion 15" as described in illustrated by Lewis. First, it would not have been obvious to make the central tubular channel of Vogrin's device removable as it essentially holds the magnet 17 and steel wool 18, or magnetic beads 30 as illustrated in Figure 2, in place in the cartridge 11. If the central tubular channel of Vogrin's device were capable of being modified as suggested by the Examiner, the combination of the magnet 17 and steel wool 18 would not be positioned as desired during removal and insertion of the extended stud portion 15 described by Lewis, and the magnetic beads 30 would fall out of the cartridge 11 upon removal of the extended stud portion 15. Secondly, the extended stud portion 15 described and illustrated by Lewis does not provide a threaded portion adapted to engage a threaded stud as recited in Claim 1.

Thus, as the suggested combination of Vogrin and Lewis would not have been obvious to one of ordinary skill in the art at the time of the invention, Applicant respectfully submits Claim 1 for further review as patentable subject matter.

As Claims 10 and 19 recite limitations similar to those recited in Claim 1, the arguments with respect to Claim 1 similarly apply to Claims 10 and 19. In addition, with respect to Claim 19, Fearnhead does not cure the deficiencies of the suggested combination of Vogrin and Lewis

Appl. No. : 10/032,215
Filed : December 21, 2001

with respect to Claim 1 in that Fearnhead provides no teaching or suggestion to modify Vogrin to include a removable hollow insert as recited in Claim 1. Fearnhead is merely cited for teaching the "[enclosure] of a filter member within a housing by first placing the filter member in a lower portion 11 of the housing followed by enclosing the filter member in the housing by attaching a perforated upper portion 13 to the lower portion ...". *Office Action, page 7, lines 8-12*. Thus, Claims 10 and 19 are respectfully submitted for further review as patentable subject matter.

Because Claims 2-9, 11-18, 20, 21, and 30 depend from Claims 1, 10 and 19, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features. For all of these reasons, Applicant respectfully requests withdrawal of this rejection.

New Claims

New Claim 31 has been added and recites features of the invention as outlined by the Examiner's proposed amendment to the independent claims in the facsimile communication of November 27, 2003. As stated by the Examiner in the proposed amendment document, "Reinosa is considered the closest prior art, however, the references fail to teach or suggest" all of the elements of New Claim 31.

Because Claims 32-37 depend from Claim 31, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features.

CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes pursuant to statutory sections 102, and/or 103, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Appl. No. : 10/032,215
Filed : December 21, 2001

Any new claims presented above are simply additional specific statements of inventive concepts described in the application as originally filed.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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